

REMARKS

Re-examination and reconsideration of the subject matter identified in caption, pursuant to and consistent with 37 C.F.R. §1.116, and in light of the remarks which follow, are respectfully requested.

Claims 44-49 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement for the reasons set forth in paragraph (1) of the Office Action. Reconsideration and withdrawal of this rejection is respectfully requested for at least the following reasons.

The disclosure on page 20 of the specification states that the true dimer units in the isocyanate functions are equal to or less than 30%. The disclosure also indicates that this ratio is advantageously less than 15%, preferably less than 12% (mass/mass). The relevant working examples disclose the weight percentages of true dimers based on the weight of the polyisocyanate composition.

From the above, it is clear that the language of the claims refers to the weight percent of true dimers based on the weight of the polyisocyanate compositions containing the dimers. Thus, claim 44 specifies that the amount of biuret is at least 10% by weight and the amount of true dimer is not more than 30% by weight of the composition.

Claims 39-43 were rejected under 35 U.S.C. §112, first paragraph, as non-enabling and lacking a written description for the reasons set forth in paragraphs (2) and (3) of the Office Action. Reconsideration and withdrawal of these rejections are respectfully requested for at least the following reasons.

The disclosure on page 16 of the specification indicates that the products of the previously described processes (which are similar to those set forth in claims 39-43) are trimers containing an isocyanurate ring of formula VIII formed by cyclotrimerization and

compounds containing a biuret unit of formula IX formed by biuretization. It is reasonable to conclude from this disclosure that the catalyzed cyclotrimerization reaction also results in biuretization.

The formation of compositions containing biurets and dimers is discussed on page 23, line 33 to page 24, line 1. Example 12 on page 39 indicates that biurets containing polyisocyanate groups are commercial products (last paragraph). Applicants submit that those of ordinary skill would recognize that Applicants were in possession of the claimed invention and would be able to practice the processes of claims 39-43 based on their knowledge, disclosures in the prior art, and the present disclosure. Respectfully, it is the Examiner's burden to provide cogent reasons on why those of ordinary skill in the relevant art would not be able to practice the invention defined by the claims based on a review of the specification coupled with the technical knowledge possessed by the routineer in the art. Applicants respectfully submit that the entire specification and the working examples when coupled with the technical knowledge possessed by those of ordinary skill in this art clearly enables those of ordinary skill to recognize that the invention is described in the specification and to practice the presently claimed invention.

Accordingly, the §112, first paragraph, rejections should be reconsidered and withdrawn. Such action is earnestly requested.

Claims 44 and 45 were provisionally rejected on the ground of obviousness double patenting over claim 68 of copending application, Serial No. 09/485,533. The Examiner's reasons are set forth in paragraph (5) of the Office Action. This rejection is moot in view of the cancellation of claim 68 in an Amendment recently filed in Application No. 09/485,533.

In reply to the Examiner's comments in paragraph (7) of the Office Action, Applicants point out that the expression "in the absence of dimerization catalyst" is clearly defined on page 6, lines 2-6, of the specification.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (703) 838-6683 at his earliest convenience.

Respectfully submitted,

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